

### **REMARKS/ARGUMENTS**

After entry of this amendment claims 48, 51-69, and 114-389 are pending.  
Applicants respond to the office action using the paragraph numbering of the office action.

¶1. Claims 126-390 have been re-numbered 125-389, respectively, as requested by the Examiner.

¶2. Claims 48, 114, 122, 131, 147, 155, 163, and 171 are rejected under 35 U.S.C. § 112, second paragraph as allegedly being confusing in reciting the limitation "comprising a sequence of nucleotides that encodes SEQ ID NO: X or a complementary sequence of any such nucleotides." Claims 48, 114, 122, 131, 147, 155, 163, and 171 have been amended to recite, *e.g.*, "[a]n isolated nucleic acid, comprising a sequence of beta-secretase encoding nucleotides, the beta-secretase encoding nucleotides consisting of nucleotides encoding SEQ ID NO: 43 or a perfect complementary sequence of any of such nucleotides." The amended claims contain an embedded "consisting of" clause. The claims are open to nucleic acids other than nucleic acids encoding beta-secretase but limited to the beta-secretase recited by the SEQ ID NO.

¶3. Rejections Under 35 U.S.C. § 102(e)  
Claims 48 and 51-57; 114-121; 122-130; 131-138; 139-146; 147-154; 155-162; 163-170; and, 171-178 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by US 6,420,534 with priority to US Application No. 60/101594. The claims have been amended as discussed above for ¶2. The '594 application does not disclose the beta-secretase consisting of any of the SEQ ID NOS recited by the amended claims.

The priority document of Gurney (US Application No. 60/101,594 filed September 24, 1998) differed in many respects from the granted patent, US 6,420,534. Particularly, the priority document misidentifies the location of the transmembrane region of its isolated aspartyl protease (see p. 20), does not identify the signal sequence or pro region

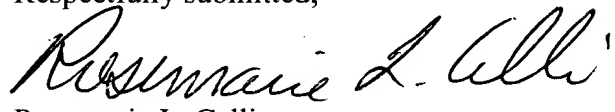
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Amendment dated September 1, 2005  
Reply to Office Action of March 1, 2005

occupying amino acids 1-21 and 22-45 of the protein, misidentifies the function of its aspartyl protease as gamma secretase (*see* title), and does not express its aspartyl protease as a protein. Because '594 application misidentifies the location of the transmembrane region, it does not describe or enable nucleic acids encoding forms of beta secretase lacking a transmembrane region. Applicants point out that in an office action in a related Gurney application, US Application No. 09/548,368, Examiner Turner rejected Gurney's arguments (presented by declaration) that he was entitled to priority for the "location of the transmembrane domain, or particular mutant lacking specific residues corresponding to the transmembrane domain and for deletion mutant lacking such specific residues which retain activity." Copies of the declaration presenting Gurney's argument, the office action holding Gurney was not entitled to priority, as noted above, and the '594 application, were cited as cite numbers 150-152, respectively, by the supplemental IDS filed February 16, 2005.

Based on the foregoing, applicants request withdrawal of the rejection.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

  
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